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09/547,540	04/12/2000	William Alloca	249768019US2	5837

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EXAMINER

GARG, YOGESH C

ART UNIT

PAPER NUMBER

3625

DATE MAILED: 01/10/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Applicati n N .

09/547,540

Applicant(s)

ALLOCA ET AL.

Examiner

Yogesh C Garg

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) ☒ Responsive to communication(s) filed on 12 April 2000 and 13 April 2001.

2a) ☐ This action is FINAL.

2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) ☒ Claim(s) 1-129 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.

6) ☒ Claim(s) 1-129 is/are rejected.

7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.

8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

9) ☒ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☐ All b) ☐ Some \* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.

2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 8.

4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other:

## DETAILED ACTION

### *Specification*

1. The disclosure is objected to because the specification does not include a brief summary of the Invention or general statement of the invention as set forth in 37 CFR 1.73. Appropriate correction is required. See MPEP § 608.01(d). The summary is separate and distinct from the abstract and is directed toward the invention rather than the disclosure as a whole. The summary may point out the advantages of the invention or how it solves problems previously existent in the prior art (and preferably indicated in the Background of the Invention). In chemical cases it should point out in general terms the utility of the invention. If possible, the nature and gist of the invention or the inventive concept should be set forth. Objects of the invention should be treated briefly and only to the extent that they contribute to an understanding of the invention.

### *Double Patenting*

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double

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patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claim 39 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of co-pending Application No. 09/151617. Although the conflicting claims are not identical, they are not patentably distinct from each other. Claim 39 of the instant application disclose receiving an indication selected from multiple procurement options from the client system but they do not teach receiving an indication of a recipient to whom the ordered item is to be delivered. However, it would be obvious to indicate a recipient from the multiple procurement options as all those options include information for completing an order and shipping it to a recipient.

This is a provisional obviousness-type double patenting rejection.

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-7, 9-13, 15-35, 37-38, 40-77, 80-92, 95-100, and 129 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hartman et al. (US Patent

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5,960,411), hereinafter referred to as Hartman, in view of Yamada (US Patent 6,336,100 B1).

With regards to 1, 9, 10, 29, 31, 32, 33, 40, 41, 42, 48, 49, 50, 56, 59, 64, 67, 68, 69, 83, 84, 85, 99, and 100, Hartman discloses a method, a system, a computer-readable medium, and a display device for a user at a client system to place an order for an item to be received by a server system. The client system displays the information identifying the item, an element representing order fulfillment instructions for the identified item, receiving indication of the recipient with predefined order fulfillment information including a delivery address, shipping instructions, and a payment source, and after selection by the user of a displayed indication sending to server computer a request to order the identified item such that the identified item is to be sent to the delivery address for the selected recipient using the shipping instructions and to be paid for by the payment source for the selected recipient, so that a single action orders and pays for the item (see at least FIGS 1A-1C, 2-7, 8A-8C, col.2, line 50-col.9, line 53). Hartman also teaches to create new procurement option for ordering the identified item (see at least Fig.1B, "...Review or change your 1-click orders ", col.4, line 59-col.5, line 8). Hartman further teaches that a client identifier corresponds to multiple customers and these multiple customers can be identified by selecting a partially displayed purchaser-specific order information (see at least col.9, lines 54-63). Hartman does not expressly teach displaying multiple groups/procurement options having information related to ordering the identified item. Yamada, in the same field of online shopping, teaches displaying multiple groups/procurement options having information related to

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ordering the identified item and allowing the user to select one of the multiple groups/procurement options (see at least FIGS. 2, 4, 5,6,9, col.1, lines 12-44, col.2, lines 57-65, col.3, lines 6-18, col.4, lines 15-30,). In view of Yamada, it would have been obvious to a person of an ordinary skill in the art at the time of the invention to modify Hartman to display multiple groups/procurement options having information related to ordering the identified item as expressly taught in Yamada. Doing so would allow the user the novelty and the convenience to order items online for different destinations for him and/or gifts for individuals other than him (see at least col.1, lines 11-44, and col.3, lines 6-19).

Hartman/Yamada further teaches all the limitations cited in claims 2-7, 11-13, 15-28, 30, 34-35, 37, 38, 43-47, 51-55, 57-58, 60-63, 65-66, 70-77, 80-82, 86-92, 95-98, and 129, (see Hartman, col.2, line 51-col.10, line 14, and Yamada, col.1, line 19-col.5, line 20).

6. Claims 8, 79, and 94 are rejected under 35 U.S.C. 103(a) as being obvious over Hartman/Yamada in view of Official Notice.

With regards to claim 8, Hartman/Yamada teaches a method for a user at a client system to place an order for an item, the user having a plurality of groups of predefined order fulfillment information as disclosed in claim 1 and analyzed above.

Hartman/Yamada does not disclose displaying an indication selecting a default groups out of the identified multiple groups. Official Notice is taken of both the well-known concept and benefits of providing a default program while working on the computers

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when several choices are available to the user to select one. If a user does not specify an alternative the program makes a choice automatically. In view of this well-known concept and its benefits it would have been obvious to a person of an ordinary skill in the art at the time of the invention to include default program in Hartman/Yamada because if a user wants the purchased item to be delivered at his home then he can save time by not being bothered to select delivery information (see at least Yamada, Fig.9, col.3, lines 6-19) as the default program will automatically indicate the server in Hartman/Yamada to select home address if the user has not made any selection of the available multiple groups.

With regards to claims 79 and 94, Hartman/Yamada teaches a method for a user at a client system to place an order for an item by indicating a single action, wherein the user have multiple procurement options of predefined order fulfillment information as disclosed in method claims 69 and 87 and analyzed above. Hartman/Yamada does not disclose adding a message to the supplied item. Official Notice is taken of both the well-known concept and benefits of sending a message with the supplied item as a gift to a person from the user. Hartman/Yamada (see at least Yamada, col.3, lines 6-12) discloses indicating a selection of an option to deliver the item as a gift. In view of this well-known concept of including a message while ordering a gift for a recipient it would have been obvious to a person of an ordinary skill in the art at the time of the invention to include it in Hartman/Yamada because the recipient would know who has sent that gift and the user would feel satisfied by expressing his feelings of goodwill towards the recipient.

7. Claims 14, 36, 78, and 93 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hartman/Yamada in view of Holland et al. (US Patent 6,493,742), hereinafter referred to as Holland.

With regards to claims 14, 36, 78, and 93, Hartman/Yamada teaches a method for a user at a client system to place an order for an item by indicating a single action, wherein the user have multiple procurement options of predefined order fulfillment information as disclosed in method claims 10, 33, 69, and 87 and analyzed above. Hartman/Yamada discloses indicating a selection of an option to deliver the item as a gift (see at least Yamada col3., lines 6-12). Hartman/Yamada does not disclose that the order request includes wrapping instructions for the item to be delivered. As per knowledge generally available wrapping gifts before delivering to the recipients is notoriously well known practice. In the same field of on online ordering gifts, Holland teaches including wrapping instructions while ordering a gift (see at least col.1, lines 26-46). In view of Holland and knowledge generally available it would have been obvious to a person of an ordinary skill in the art at the time of the invention to include the wrapping instructions in Hartman/Yamada, while delivering a gift, because a wrapped gift provides more excitement to the recipient than an unwrapped gift.

8. Claim 39 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hartman/Yamada in view of Polnerow et al. (US Patent 5,813,006), hereinafter referred to as Polnerow.



With regards to claim 39, Hartman/Yamada teaches a method for a user at a client system to place an order for an item by indicating a single action, wherein the user have multiple procurement options of predefined order fulfillment information as disclosed in method claim 33 and analyzed above. Hartman/Yamada does not disclose the step, if server system does not have sufficient information for the selected procurement option to deliver the identified item, obtaining additional information from an external source to deliver the identified item. However, Polnerow expressly teaches, if the server system does not have sufficient information to deliver the identified item, obtaining additional information from an external web site other than the server to deliver that item (see at least Figs. 3-9, col.2, line 24-col.9, line 56). In view of Polnerow, it would have been obvious to a person of an ordinary skill in the art at the time of the invention to modify Hartman/Yamada to incorporate the concept and benefits of Polnerow to be able to obtain additional information about the recipient from an outside source/website as expressly suggested in Polnerow (col.1, lines 9-25).

9. Claims 101-106, 108-122, 124, 126-128 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hartman/Yamada and further in view of Holland et al. (US Patent 6,493,742), hereinafter referred to as Holland.

With regards to claims 101, 111-113, and 127-128, Hartman/Yamada teaches a method, a system, and a computer-readable medium, for a user at a client system to place an order for an item to be received by a server system. The client system displays the information identifying the item, an element representing order fulfillment

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instructions for the identified item, receiving indication of the recipient with predefined order fulfillment information including a delivery address, shipping instructions, and a payment source, and after selection by the user of a displayed indication sending to server computer a request to order the identified item such that the identified item is to be sent to the delivery address for the selected recipient using the shipping instructions and to be paid for by the payment source for the selected recipient, so that a single action orders and pays for the item (see at least Hartman, FIGS 1A-1C, 2-7, 8A-8C, col.2, line 50-col.9, line 53) as disclosed and analyzed above for claims 1, 9, 10, 29, 31, 32, 33, 40, 41, 42, 48, 49, 50, 56, 59, 64, 67, 68, 69, 83, 84, 85, 99, and 100 .

Hartman/Yamada further expressly teaches displaying multiple groups/procurement options having information related to ordering the identified items or gifts to be delivered to the user or to a person other than the user (see at least Yamada, FIGS. 2, 4, 5,6,9, col.1, lines 12-44, col.2, lines 57-65, col.3, lines 6-18, col.4, lines 15-30,).

Hartman/Yamada does not disclose that a first user identifies the item and the second user performs a single action to send the order request to the server for the item identified by the first user. However, Holland teaches that a first user identifies the item and the second user performs a single action to send the order request to the server for the item identified by the first user (col.6, lines 9-61, col.9, lines 7-36, Figs.1, 4, 5, 6, 7, 8. Note: In Holland registrant is the first user who identifies the item and guest is the second user who executes a single click purchase for the identified gift item by the first user). In view of Holland, it would have been obvious to a person of an ordinary skill in the art at the time of the invention to modify Hartman/Yamada to incorporate Holland's

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feature of letting a first user i.e. registrant to identify the gift and let a second user i.e. a guest to execute the order by using single click program. Doing so will enable relatives and friends to execute on-line orders for gifts selected by the recipients and thus eliminating the possibility of recipient rejecting or not liking the gifts.

10. Hartman/Yamada/Holland further teaches all the limitations cited in claims 102-106, 108-110, 114-122, 124, and 126, (see at least Hartman, col.2, line 51-col.10, line 14, Yamada, col.1, line 19-col.5, line 20, and Holland col.1, line 5-col.9, line 36).

11. Claims 107, 123, and 125 are rejected under 35 U.S.C. 103(a) as being obvious over Hartman/Yamada/Holland in view of Official Notice.

With regards to claims 107 and 123, Hartman/Yamada/Holland teaches a method for a second user at a client system to place an order for an item identified by a first user by indicating a single action, as disclosed in method claims 101 and 113 and analyzed above. Hartman/Yamada/Holland does not disclose adding a message to the supplied item. Official Notice is taken of both the well-known concept and benefits of sending a message with the supplied item as a gift to a person from the user.

Hartman/Yamada/Holland (see at least Yamada, col.3, lines 6-12) discloses indicating a selection of an option to deliver the item as a gift. In view of this well-known concept of including a message while ordering a gift for a recipient it would have been obvious to a person of an ordinary skill in the art at the time of the invention to include it in

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Hartman/Yamada/Holland because the recipient would know who has sent that gift and the user would feel satisfied by expressing his feelings of goodwill towards the recipient.

12. With regards to claim 125, Hartman/Yamada/Holland teaches a method for a second user at a client system to place an order for an item identified by a first user by indicating a single action, as disclosed in method claim 113 and analyzed above. Hartman/Yamada/Holland does not disclose using a specified cost threshold to allow purchase of the identified gift item by the first user. Official Notice is taken of the generally available knowledge that all purchases online are subject to a specified cost threshold such that the purchase value does not exceed the credit value available to the user. In view of this well-known concept of subjecting the purchases to a specified cost threshold such that the purchase value does not exceed the credit value available to the user it would have been obvious to a person of an ordinary skill in the art at the time of the invention to incorporate it in Hartman/Yamada/Holland because the second user would be safeguarded against paying a value which he regards high and have not considered to pay that for the identified gift item.

### ***Conclusion***

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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(i) Trommer, Diane, " A New Wave in online credit ", Electronic Buyers' News, 01646362, 3/4/96, issue 996, 2 pages, extracted from "Business source corporate " Database on Internet on 01/07/2003, teaches single click transactions online.

(ii) Copy of Federal Circuit Court of appeal's decision, " Amazon.com v. barnesandnoble.com, et al., Civ.Act.No. 00-1109, 239 F.3d 1343 (Fed.Cir., Feb 14, 2001 made on February 14, 2001", 37 pages, extracted from Internet on 01/07/2003 discloses prior art on single-click transactions (see at least pages 7, 26-36) which mount a serious challenge to the validity of patent 5,960,411 (see at least page 25).

(iii) US Patent 5,826,242 to Montulli discloses a method and an apparatus for on-line shopping utilizing persistent client state in hypertext transfer protocol based client-server system.

(iv) US Patent 5,870,717 to Wiecha teaches obtaining or updating information about addresses of the recipients in an online ordering system in a corporate environment.

(v) US PUB.No: 2002/0019776 A1 to Simpson teaches a method and a system for enabling a one person to produce a customized gift for a second person.

(vi) US PUB.NO: 2002/0178089 A1 to Bezos et al. teaches a method and a system to coordinate a delivery of gift.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yogesh C Garg whose telephone number is 703-306-0252. The examiner can normally be reached on M-F (8:30-4:00).


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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn W Coggins can be reached on 703-308-1344. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-7687 for regular communications and 703-305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

Yogesh C Garg  
Examiner  
Art Unit 3625

YCG  
January 8, 2003

  
WYNN W. COGGINS  
SUPERVISORY PATENT EXAMINER  
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